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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,642	03/01/2004	Robert G. Farrell	YOR920040099US1	9768

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EXAMINER

LEWIS, CHERYL RENE A

ART UNIT	PAPER NUMBER
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2167

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/25/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/790,642

Applicant(s)

FARRELL, ROBERT G.

Examiner

Cheryl Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 23-33, and 36-39 is/are rejected.
- 7) ☒ Claim(s) 20-22, 34, 35 and 40 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the applicants' communication filed on November 7, 2006.
2. Claims 1-40 are presented for examination.
3. The applicants have amended claims 1, 4, 17, 20, 25, 27, and 31 in the amendment received on November 7, 2006.
4. Applicants' arguments filed on November 7, 2006 have been fully considered but are not deemed to be moot in view of the new grounds of rejection.

Remarks

5. The Examiner kindly requests that the applicant reviews the claims and remove the typo errors (i.e., qqqq, :, etc.) presented in the pending claims.

Claim Objections

6. Claims 20-22, 34, 35, and 40 objected to because of the following informalities:

Independent claim 20 is being objected to because of a minor informality to the preamble. The examiner recommends that the applicants consider amending the preamble to include hardware. The preamble should recite a 'computer implemented' method. Appropriate correction is required.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1, 12, and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:

Claims 1, 12, 17, 19, 23-27, 29-33, 37, and 39 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 17, 25, 27, and 31 collectively are directed to search queries, mapping relevant objects, connecting categories to paths, and choosing a best path for a criterion based on the relevance of the mapped objects.

The claimed inventions, as a whole must accomplish a **practical application**. That is, it must produce a **“useful, concrete, and tangible result.”** *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. MPEP 2106. In each of these cases the **result** is mapping and connecting categories. The claimed limitations are an abstraction as they are not **useful, concrete, and tangible**, they are not put in any tangible form and not useful because they are not presented in a way to provide some result that is of utility that may exist in the specification however no specific use is provided for in the claimed invention. Thus the claims are non-statutory and stand rejected under 101 as not producing a **“useful, concrete, and tangible result.”**

Although, independent claims 1, 17, 25, 27, and 31 are performing a query search, the independent claims do not provide a useful, concrete, and tangible result about the results of the query search. What happens to the query search in these

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claims as a result of information being searched for? Is the query search conducted in an effort to retrieve data for display, output, etc. Also, claims 1, 17, 25, 27, and 31 should be amended to state that the search query is being implemented by hardware. The examiner recommends amending the preamble of the claims to state a 'computer implemented' method, apparatus, or system.

Likewise, dependent claims 12, 19, 23, 24, 26, 29, 30, 32, and 33 are non-statutory because these dependent claims comprise an article of manufacture or a program storage device, while their dependency depends on independent claims that are claiming an apparatus or method.

Thus, the remaining dependent claims not mentioned in the above rejections are also rejected for being dependent upon the above recited independent claims, these claims are also rejected for the reasons set forth above.

NAME OF CONTACT

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cheryl Lewis
Patent Examiner
January 19, 2007